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REMARKS

Examiner Reimers is thanked for vacating the prior final action in her new Office Action dated March 19, 2007. However, the allowability of claims 3-12, 15-31, 42-47 and 50-67 was withdrawn in the current action, and rejections were made over a newly-cited reference. Claims 13, 14, 48, 49, and 68 were indicated as having allowable subject matter. Based on the following, Examiner Reimers is respectfully requested to reconsider the claims, and pass them to allowance.

Objection to the Specification

Examiner Reimers is thanked for pointing out a typographical error in the specification regarding a number in the drawings. That error is being corrected with the amendment to the specification noted above. No new matter has been added.

Full Faith and Credit Should Be Given to Claims Acknowledged Allowable

Respectfully, 3-31 and 42-68 were indicated to have allowable subject matter by Examiner John Kim in an action dated May 16, 2006, and Examiner Reimers agreed with that stance in her action dated November 16, 2006. The MPEP states that

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

MPEP 706.04. There is no indication in the record of any clear error by either Examiner Kim or Examiner Reimers. It is submitted that because two different examiners, in two different actions,

acknowledged their allowability, and because no reason appears for the new approach taken in the present Office Action, the allowability of all of claims 3-31 and 42-68 should be reinstated.

*The Koros Reference Does Not Anticipate Claim 3*

Moreover, the Koros reference (U.S. Patent No. 5,273,519) does not anticipate any of claims 3-12, 15-31, 42-47, 50-67 or 69-70. With due respect, the Office Action is unclear as to what parts of the Koros reference allegedly constitute parts of the claimed subject matter. For example, the last four lines of page 2 of the Office Action allege that Koros discloses "a base comprising an upper base portion and a lower base portion (see various embodiments of figures 2, 19 and 23)." That language does not identify with any particularity what in Koros could be a "base," an "upper base portion," or a "lower base portion." The identification of a "pivotable plate" and an "indentation" in a "shaft" is not very clear either.

Claim 3 recites several things that are not shown or suggested by the Koros reference. Claim 3 recites an apparatus "for connecting to an orthopedic implant." The Koros reference, on the contrary, is a rongeur, a device that removes tissue from a surgical site. See Koros, column 3, lines 18-34. The Koros device is provided with a cutting tip for removing tissue, and there is no indication in the reference that it is possible to use such a tip (or any other part of the Koros device) to connect to an implant. Respectfully, the Office Action does not provide any evidence for the conclusion that the Koros device could be used for the recited functions of the claim.

Claim 3 also recites a "plate having an aperture," which is "pivotably connected" to a shaft so that the plate can have a "position for locking to an implant" and a "position for accepting insertion of a part of an implant." As best can be determined, the Office Action

compares the recited "plate" to a part of item 122 (Fig. 4), or items 150 and 160 (Fig. 18). As to item 122, Koros identifies it as a socket in an upper end of handle 20, in which the proximal end 90 of shaft 30 fits so that handle 20 can move shaft 30. Item 122 is not a "plate," and it does not have any position for locking to an implant or for accepting insertion of a part of an implant. Indeed, item 122 is an interior piece surrounded by a frame 15 (see, e.g. Fig. 2), and thus cannot lock to or accept insertion of an implant. As to items 150 and 160, they form a "scoop" for tissue (see column 9, lines 38-43), which again cannot have positions for locking or insertion of an implant. No locking structure is shown, and in fact there is no part of items 150/160 that could anchor against or firmly hold an implant. If an implant were between items 150/160, for example, it would fall or pull right out. The only function of the "scoop" is removing a larger amount of tissue, and an implant cannot be locked to or inserted in a "scoop" that has a closed outside and no way to insert or lock an implant.

Claim 3 also recites a sleeve at least partially surrounding a shaft and being slidable along the shaft and with respect to the recited base and plate. No part of Koros' device has all of those attributes. The Office Action seems to suggest that three items, 25, 26 and 27, could be such a sleeve. Items 25, 26 and 27 are respectively described as a "barrel" (see column 7, line 40; column 10, line 11), a "conical flare" of the barrel (column 10, line 17), and a "chamber cover" integral with the barrel (see column 10, lines 11-12). Those items are not slidable along shaft 30, and they are not slidable with respect to frame 15 or whatever other structure in Koros that the Office Action might consider to correspond to a "base" or "plate" as recited in the claim, if any. The respective slidability of the sleeve with respect to a shaft and a base as recited in the claim is particularly useful, in one embodiment, as recited in paragraph 0041 of the present application.

Claim 3 further recites a ratchet mechanism connected to the recited base and sleeve. The Office Action points only to Figures 10 and 11 of the Koros reference, without identifying any particular structure as allegedly corresponding with the recited mechanism. It appears that the Office Action considers the "star gear" 130 of those Figures to be a "ratchet mechanism." Column 10, lines 36-51 of Koros explain that the "star gear" is connected to a "stationary shaft" 35, and the two can be rotated to several positions by pressing a lever 65 to disengage lock 66 from "star gear" 130. The gear is not a "ratchet mechanism" as claimed, at least because it cannot be forced in one direction and not another, and moreover it is not connected to a sleeve. As noted above, the Office Action suggests that barrel pieces 25, 26 and 27 are a "sleeve," but gear 130 is not connected to the barrel. Rather, it is connected to the "stationary shaft" 35. The recited "ratchet mechanism" also moves the sleeve with respect to the base and the recited shaft. Gear 130 of Koros does not move any part of barrel 25.

Claim 3 further recites a handle with an actuator, where the actuator operates the recited ratchet mechanism. While the Office Action alleges that item 22 in Koros is an actuator, it is assumed that handle 20 is meant. However, handle 20 does not operate gear 130. Rather, handle 20 pushes shaft 30 forward, through gear 130 without any effect on gear 130. Gear 130 can only be turned, apparently by hand, when a lever 65 is pressed to disengage lock 66 from gear 130. Notably, lever 65 does not operate gear 130 as recited in the claim, but only frees gear 130 so that it can be moved by the surgeon.

To summarize, it has been demonstrated that the Koros reference lacks several features recited in claim 3. It is respectfully requested that the rejection of claim 3 based on this reference be withdrawn.

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*The Koros Reference Does Not Anticipate Claims 4-10*

Claims 4-10 are dependent from allowable claim 3, and are allowable either on their own merit or due to that dependence. For example, claim 8 recites two leaf springs connected together to bias an actuator and a stock apart. Two leaf springs are not shown in the Koros reference for that purpose. The task of item 50 is to hold a "carriage" against the inside of a stationary handle (column 8, lines 3-9), and thus does not bias apart handle 20 from handle 10. As another example, the stop recited in claim 9 is absent from Koros. The Office Action points to Figures 10 and 11, but does not identify any particular item that could be such a stop. Assuming that the Office Action intended to suggest that lock 66 is such a "stop," it is clear that lock 66 does not prevent or permit motion of a sleeve in a rearward direction. First, as noted above, barrel 25 (which the Office Action considered a "sleeve") does not move at all. Second, the lock 66 prevents rotational motion of gear 130 when they are engaged, and permits rotational motion when they are disengaged. As seen in Koros' Figures 10 and 11, lock 66 cannot prevent movement out of the plane of the page, and thus it has nothing whatever to do with any rearward motion of gear 130, shaft 30, or like part of the Koros device.

*The Koros Reference Does Not Anticipate Claims 11-14*

Independent claim 11 includes features discussed above with respect to claims 3 and 9, including features of the recited plate, the recited sleeve, the recited ratchet mechanism, and the recited stop. It has been demonstrated that the Koros reference does not show all of these features, and so it is respectfully requested that the anticipation rejection of claim 11 be withdrawn. Claim 12 is allowable because of its dependence from claim 11, and because the

Koros reference does not show a pivotable pawl as recited. The Office Action did not state what item in Koros it considers to be the pawl, but its reference to Figures 10 and 11 of the reference suggest that perhaps tooth 64 might be indicated. Even if that is the case, however, Figures 10 and 11 do not show a pivotable pawl. Instead, it shows a lock 66 with a tooth 64 that is moved linearly toward and away from gear 130. Without an explicit disclosure, or a demonstration that pivotability must follow from the disclosure, the Koros reference cannot anticipate claim 12. Claims 13 and 14 have already been declared to have allowable subject matter.

*The Koros Reference Does Not Anticipate Claims 15-18*

Independent claim 15 includes recitations of features discussed above with respect to claim 3, including features concerning the recited plate and the recited sleeve. For at least the reasons given above concerning those features, the Examiner is respectfully requested to withdraw the rejection of claim 15. Claims 16-18 are dependent from claim 15, and are allowable either on their own merit or based on that dependency. For example, claim 16 recites that the aperture of the plate has a constant diameter section. As noted above, the Office Action appeared to consider both the top of handle 20 and items 150 and 160 as "plates." Neither of those structures explicitly or inherently have a constant diameter section, the top of handle 20 having a "rounded recess" (column 9, lines 8-10) and items 150 and 160 being tapered throughout (see Figure 18). Claim 17, as another example, recites a roughened surface on said plate. Although the Office Action alleged the presence of that feature, it did not identify where it could be found, and it is not explicitly or inherently seen on the apparently smooth upper part of handle 20 and items 150 and 160.

*The Koros Reference Does Not Anticipate Claims 19-26*

Independent claims 19-22 also include features discussed above concerning the plate and sleeve recited in claim 3. For at least the same reasons identified with respect to claim 3, these claims are also allowable. In addition, claim 19 recites that the plate has a rounded surface and the shaft an indentation, with the indentation and rounded surface adjacent each other. Although the Office Action alleged that its suggested plate and shaft had the respective rounded portion and indentation, it did not point to any particular structure of Koros, and the suggested rounded portion and indentation in their recited relative position have not been found in the reference. Claim 20 recites that the plate has a rounded surface that facilitates pivoting, and again the Office Action was silent as to what part of Koros might correspond to that structure. The top of handle 20 has a rounded interior surface, but it does not facilitate pivoting, which the handle does around point 21. Item 150 appears to have a rounded front (see Figs. 16 and 18), but it also does not facilitate pivoting. As to claim 21, there is nothing on barrel 25 that is capable of contacting any of the items recited in the claim. Claim 22 recites that the recited shaft includes an elongated portion and a plunger portion. The Office Action points to items 172 and 174 with regard to those features, but those items are simply a dovetail joint, with a mortise in "stationary shaft" 35 and a tenon in shaft 30. No "plunger" portion exists in Koros. Even if "plunger" portion were to be equated with a movable portion, only portion the stationary shaft 35 has groove 174.

Claims 23-26 depend from claim 22, and are allowable either on their own merit or due to that dependency. For example, claim 24 recites a spring abutting the "plunger" to bias it forward. The Office Action asserted that items 68 and 66 are "concentric springs." However, as noted above, item 66 is a lock, not a spring, and item 68 is a flat spring that biases lock 66

upward into contact with gear 130 (column 11, lines 1-15). It thus cannot be "concentric," and moreover it does not bias a "plunger" forward. Rather, it biases lock 66 upward toward gear 130. Spring 68 has no effect on any portion of either shaft 30 or 35. Claim 25 recites two springs biasing the "plunger," which are absent from Koros, and claim 26 recites that those springs are concentric. There are no "concentric" springs in Koros.

*The Koros Reference Does Not Anticipate Claims 27-31*

Independent claim 27 includes features discussed above concerning the plate and sleeve recited in claim 3. For at least the same reasons identified with respect to claim 3, these claims are also allowable. Claims 28-31 depend from claim 27, and are allowable either on their own merit or due to that dependency.

*The Koros Reference Does Not Anticipate Claims 42, 66 and 67*

Independent claim 42 recites an apparatus for use in orthopedic surgery, comprising among other things a shaft connected to a plate member adjacent an edge of the plate member, the shaft being movable to pivot the plate member substantially around an opposite edge of the plate member. The claim further recites a sleeve that is slidable with respect to the shaft, and that the plate member has a first relatively open position for insertion of at least part of an implant, and a second relatively closed position where the plate member can contact the implant. Respectfully, none of these features are shown or suggested by the Koros reference.

The Office Action identified shaft 30 as allegedly corresponding to the shaft of claim 42, and either the top of handle 20 or the combination of items 150 and 160 as the plate of the claim.



The shaft 30 of Koros does not pivot the top of handle 20 at all, and certainly not around an edge of that top part. Handle 20 pivots about point 21 to move the shaft 30. As to items 150 and 160, all that is stated in the Koros reference relative to pivoting is "The tip 150 on the movable shaft 155 is pivotally secured to the stationary shaft 165." That meager sentence does not enable a disclosure as in claim 42, especially since the Figures do not show how moving item 155 can draw item 150 upward from an initial position in which item 150 is flush against items 155 and 165. Further, the only place where item 155 could contact item 150 is on the same edge around which item 150 apparently pivots. Claim 42, conversely, recites that the edge to which the shaft is connected is opposite the edge around which the pivoting occurs.

Independent claims 66 and 67 also include features that are not shown in the Koros reference, and which were discussed above with respect to claim 42.

*The Koros Reference Does Not Anticipate Claims 43-54 and 68-70*

Claims 43-54 and 68-70 depend from claim 42, and are allowable on their own merit and/or due to that dependency. For example, claim 43 recites an actuator that operates a ratchet mechanism. As already shown, there is no ratchet mechanism in Koros, and its handle 20 does not operate its gear 130. Claim 45 includes two leaf springs, and as discussed previously, Koros does not show leaf springs that are connected together to bias an actuator and a stock apart. Claims 46 and 47 include the "stop" and "pawl" features discussed above, and they also are not found in Koros. Claims 69 and 70 include features noted above with respect to claims 21 and 3, and so they are also not anticipated. The Office Action declared that claims 48, 49 and 68 have allowable subject matter.

*The Koros Reference Does Not Anticipate Claims 55-57*

Independent claim 55 includes features concerning the recited plate member and shaft that were discussed with respect to claim 42, and it is allowable at least on the bases given in that discussion. Claims 56 and 57 depend from claim 55, and are allowable either on their own merit or due to that dependency. For example, claim 56 recites that the plate aperture has a constant diameter section. It has been previously pointed out that neither of the structures the Office Action put forth as the recited "plate member" have a constant diameter section.

*The Koros Reference Does Not Anticipate Claims 58-65*

Independent claims 58-61 also includes features of claim 42 relating to the recited plate member and shaft that were discussed previously, and so claim 58 is allowable at least for the reasons given with respect to claim 42. In addition, claim 58 recites that the plate member has a roughened surface adjacent its aperture, and as explained above, the Office Action did not point out a particular part of Koros for that feature, and in fact the Koros reference does not include that feature. Claim 59 recites that the plate has a rounded surface and the shaft an indentation, with the indentation and rounded surface adjacent each other. Although the Office Action alleged that its suggested plate and shaft had the respective rounded portion and indentation, it did not point to any particular structure of Koros, and the suggested rounded portion and indentation in their recited relative position has not been found in the reference. Claim 60 recites that the plate has a rounded surface that facilitates pivoting, and again the Office Action was silent as to what part of Koros might correspond to that structure. The top of handle 20 has a rounded interior surface, but it does not facilitate pivoting, which the handle does around point

21. Item 150 appears to have a rounded front (see Figs. 16 and 18), but it also does not facilitate pivoting. Claim 61 recites that the shaft includes an elongated portion and a plunger portion, and such structure was discussed above and shown to be absent from Koros.

Claims 62-65 depend from claim 61, and they are allowable either on their own merit or based on that dependency. The features of each of these claims were discussed above with respect to claims 23-26, and that discussion is equally applicable here.

### Conclusion

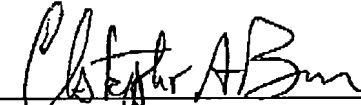
Amendments to the claims have been made, as indicated above, to place them in proper form for allowance. No narrowing of any of the claims is intended, and the claims should be allowed the full scope indicated by their language, including equivalents. New claims 69 and 70 have been added, which correspond respectively to language in original claims 40 and 41. No new matter has been added. They are dependent from claim 42, which is allowable, and at least on that basis no new issues for examination are raised. Entry of these amendments and new claims is respectfully requested.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the Office Action in the most expedient fashion. Applicant reserves the right to later contest positions taken in the Office Action that are not specifically addressed herein. Further, no limitation of the claims is intended by any of the remarks herein. The claims are intended to have the full scope to which their language entitles them, including equivalents.

In conclusion, reconsideration and withdrawal of the rejections of the claims based on the remarks presented is respectfully requested. The undersigned attorney invites Examiner Reimers to call to discuss any further issues that may remain.

Respectfully submitted,

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Page 30 of 30